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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,715	03/19/2002	Alex Roche	B-4537PCT 619589-5	7580
22879	7590	09/11/2006	EXAMINER	
HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			ALLEN, WILLIAM J	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/088,715	<b>Applicant(s)</b> ROCHE, ALEX	
	<b>Examiner</b> William J. Allen	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 17-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Prosecution History Summary***

Claims 1-12 and 13-16 are pending and rejected as set forth below.

Claims 17-31 are withdrawn from consideration.

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 10/088,715, filed on 3/19/2002.

### ***Drawings***

## **INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

### **Replacement Drawing Sheets**

Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

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### **Annotated Drawing Sheets**

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheet(s) must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings.

### **Timing of Corrections**

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

*Election/Restrictions*

Applicant's election with traverse of Group I claims 1-12 in the reply filed on December 9, 2005 is acknowledged. The traversal is on the following two grounds:

I. Applicant argues:

"In the Official Action, with respect to Groups II, III, and VI, the Examiner asserts that subsection (4) of 37 C.F.R. 1.475 applies. However, then the Examiner goes on to say that subsection (4) really does not apply before the aforementioned groups "fail to recite the manner in which they are specifically designed to carry out the method of Group I". With all due respect, it is believed that the Examiner is reading a requirement into the rule that does not exist in the rule. There is nothing in the rule that says that the claims have to "recite the manner in which they are specifically designed" for carrying out the method of another group of claims."

This argument is not found to be persuasive. As stated in 37 CFR §1.475:

"Categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process. (emphasis added)

Applicant has merely alleged that the Examiner has erred in the interpretation of the language "claims are drawn only to" in Rule 475. Even assuming, *arguendo*, that the Examiner has too narrowly construed the language of Rule 475, Applicant still has not argued the manner

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in which the claims are drawn to a process and an apparatus or means specifically designed for carrying out the said process.

II. Applicant argues:

"the examiner would not hesitate to file a double patenting rejection if the claims were filed in separate applications".

This argument is not found to be persuasive because Applicant has not specifically pointed to errors in the Examiner's requirement and has not specifically argued the manner in which the various Groups form a single general inventive concept. Applicant's allegation of a hypothetical action by the Examiner (i.e. that the Examiner would have filed a double patenting rejection) is not persuasive absent any analysis in support thereof. Any analysis based upon double patenting should include the manner in which the result of such analysis necessarily results in a finding that the claims of the Groups are so linked as to form a single general inventive concept under PCT Rule 13.1.

However, upon further consideration, the restriction requirement is modified in-part as follows:

Groups II-III have been rejoined with elected Group I. The claims of Groups II and III, upon reconsideration, have been determined to have been drawn to an apparatus or means specifically designed for carrying out the said process of Group I claims.

The requirement, otherwise, is still deemed proper and is therefore made FINAL.

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Claims 17-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected Groups IV-VI, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on December 9, 2005.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-7, 13-14, and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Blumberg et al. (US 2003/0140315, herein referred to as Blumberg).**

**Regarding claim 1,** Blumberg teaches:

*displaying a plurality of image items for remote viewing by said customer* (see at least: abstract, 0009-0010, 0014, 0016, 0075-0076, 0079, 0101, 0212, 0219, Fig. 1, 6);

*transacting an order of a first type with said customer for supply of said at least one print product* (see at least: 0015-0016, 0030, 0044, 0073, 0145, claim 17);

*transacting an order of a second type with said print merchant for fulfillment of said first type order* (see at least: 0062, 0112, 0114, 0147, 0150, 0219, claim 11, Fig. 6). The Examiner notes that creating, storing, and reviewing the content to be printed with the server is a ‘first type’ of transaction order and choosing to process and purchase the content is a ‘second type’ transaction order.



**Regarding claims 2-7, Blumberg teaches:**

(2) *wherein said step of transacting an order of a first type comprises: receiving a specification of said print products from said customer, said specification comprising data selected from the set, media size; media type; number of copies; delivery name; delivery address; ink type (see at least: abstract, 0009, 0073-0075, 0096-0097, 0126-0129, Fig. 6).*

(3) *wherein said step of transacting an order of a first type comprises receiving a specification of said print products from a customer terminal, in the form of an electronically transmitted data file (see at least: abstract, 0006, 0010, 0015, 0017, 0018, 0030, 0066, 0099, 0144).*

(4) *wherein said step of transacting an order of a second type comprises the steps: sending an order to said print merchant, specifying details of said print products; and receiving confirmation of said order from said print merchant (see at least: 003, 0062, 0112, 0114, 0116, 0147, 0150, 0219, claim 11, Fig. 6).*

(5) *wherein said step of sending an order to a said print merchant comprises sending said order in the form of an electronically transmitted data file (see at least: 0006, 0062, 0176, 0212, Fig. 6)..*

(6) *receiving a price data from said print merchant (see at least: 0032, 0073, 0074, 0125).*

(7) *obtaining an electronic image data describing a said image item; said electronic image data obtained via a communications network; and electronically sending said electronic image data to said print merchant (see at least: 0137-0138, 0143, 0184, Fig. 1 and 6).*

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**Regarding claims 13-14 and 16**, claims 13-14 and 16 closely parallel claims 1-7. Claims 13-14 and 16 are thereby rejected for at least the reasons listed above in regards to claims 1-7.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 8-10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blumberg in view PTO reference 892 U (herein referred to as 892u) in further view of Arnold et al. (US 6016504, herein referred to as Arnold).**

**Regarding claims 8-10 and 15,** Blumberg teaches all of the above as noted and teaches the relationship between an internet on demand print service working in conjunction with print service providers such as quick printers or commercial printers (see at least: 0028, 0030, 0032, 0034). Though Blumberg teaches the relationship of a company with an on demand print service and a print service provider (i.e. print merchant), Blumberg does not specifically teach *a contract between a content retailer and a print merchant and storing the contract electronically.*

892u teaches magazine publishers (i.e. a content retailer) dealing with service providers such as printers/print vendors (see at least Paragraph 1). The publisher is able to receive benefits such as volume discounts/price concessions from the vendor for providing business not traditionally received by the vendor. Vendors are able to give the publisher the price concessions/volume discounts knowing that they will receive business from a publisher as part of a deal (i.e. contract) for a given time period such as 3 years (see at least: Paragraphs 23-26). It would have been obvious to one of ordinary skill in the art at the time of invention to have

modified the invention of Blumberg to have included *a contract between a content retailer and a print merchant* as taught by 892u in order to provide a mutually beneficial agreement that provides for volume discounts/price concessions to a content retailer while assuring a print merchant receives guaranteed business that otherwise it would not receive (see at least: 892u, Paragraph 25). The Examiner notes that the price is determined based on the agreement.

Blumberg in view of 892u teach all of the above as noted. Blumberg in view of 892u, however, do not show *storing an electronic contract*. Arnold teaches establishing a contract relationship between a virtual outlet (i.e. retailer) and a merchant (see at least: abstract, col. 11 lines 35-43). More particularly, a virtual outlet and merchant enter into a contract with the contract being stored electronically (col. 10 lines 32-34, col. 11 lines 35-43, col. 13 lines 51-57, Fig. 9, 11, and 20). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Blumberg in view of 892u to have included *storing an electronic contract* as taught by Arnold in order to allow the merchants, retailers, etc. involved to easily access and change the terms of the contract if desired (see at least: (col. 10 lines 32-34, col. 11 lines 35-43, col. 13 lines 51-57, Fig. 9, 11, and 20).

**3. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blumberg in view of von Rosen et al. (US 6493677, herein referred to as von Rosen).**

**Regarding claims 11 and 12,** Blumberg teaches all of the above as notes and further teaches, for a multiplicity of service providers, creating, routing, and presenting billing information based on the contents of the print order. Blumberg also teaches where the billing information based on the delivery option selected and print price (see at last: 0032, 0074, 0117, 0122-0130). Blumberg, however, lacks the aspect of *itemizing* the various prices/costs on the bill. Von Rosen teaches a system allowing users to submit digital images, edit and customize those images, and have those images branded (i.e. printed) on merchandise labels (see at least: abstract). Von Rosen also teaches *itemization* of the bill including distinctly/separately showing the shipping (i.e. delivery) cost as well as the purchase price (see at least: Fig. 10A-11B). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Blumberg to have included *itemization* of various costs including delivery price and print price as taught by von Rosen in order to provide a system that displays a summary of an order including a short description of the order and permit a user to return to any previous page to correct any incorrect items (see at least: von Rosen, col. 10 lines 59-67).

*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 5563722 discloses a method and apparatus for assembling a photographic album
- US 20020046129 discloses an apparatus and technique for on-demand printing, and on-demand printing services

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J. Allen  
Patent Examiner  
August 25, 2006

 primary examiner